

REMARKS

Claims 1 to 21 are pending. No amendments have been made to the claims.

No additional fees are believed due. However, the Director is hereby authorized to charge any deficit, or credit any overpayment, to Deposit Account No. 08-2525.

REJECTION OF CLAIMS 1 TO 21 AS ANTICIPATED BY BLEICHER ET AL.

Claims 1 to 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bleicher et al. (WO 00/63166). In particular, the Office Action asserts that Bleicher et al. disclose oxazole compounds wherein at least one of the compounds anticipates the claimed invention. Formula IB-b on page 3 of Bleicher et al. is cited for support of this assertion.

Applicants respectfully traverse this rejection because Bleicher et al. does not teach each and every limitation of the claimed invention. For Bleicher et al. to teach each and every limitation of the claimed invention, some portion of the reference would have to describe a compound or genus that is wholly encompassed by the claims of the instant invention. It does not.

It is well established that where a reference discloses a genus that is broader than the claimed invention or overlaps the claimed invention, it does not anticipate the claimed invention. In such an instance, as here, one skilled in the art would have had to pick and choose amongst possible variables in the reference to arrive at the claimed invention.

With regard to the compound of formula IB-b on page 3 of the reference, it is noted that the genus described by the reference is broader than that of the claimed invention. For example, compound IB-b has a fused ring system containing three rings, as does formula I of the instant claims. However, the central ring of the IB-b compound contains the variable X which can be either oxygen or sulfur. In contrast, compounds of formula I in the instant claims cannot contain a

sulfur atom. Thus, the skilled artisan would have to choose between the two options, oxygen and sulfur, to arrive at the ring in the instant compounds.

Similarly, the two side rings of the fused ring system in compounds of formula IB-b can be a phenyl ring or a 6-membered heterocyclic ring containing one or two nitrogen atoms. In contrast, rings in the same positions of the compounds of the instant claims cannot be a heterocyclic ring. Thus, the skilled artisan would have had to pick and choose among the possible rings for each of the two rings attached to the central ring in formula IB-b to arrive at the fused ring system of the instant claims.

Further, one of the substituents on the oxazole ring in the Bleicher et al. reference can be lower alkyl, lower alkoxy, cyclohexyl, lower alkyl-cyclohexyl, or trifluoromethyl. In the instantly claimed compounds, there can be no lower alkyl, lower alkoxy, cyclohexyl, or lower alkyl-cyclohexyl group attached to the oxazole ring. Again, the skilled artisan would have to pick and choose amongst the possibilities to obtain the substitution of the instantly claimed compounds. Thus, it is clear that the instant application is a selection invention, narrower in scope than that disclosed in the Bleicher et al. reference.

Therefore, the reference do not anticipate but, at best, obviates the instant invention. As this reference and US Patent No. 6,462,198, also applied in the Office Action, are related, the issue of obviousness with regard to this reference will be discussed below with regard to the obviousness-type double patenting rejection.

For at least these reasons and those provided with regard to the obviousness-type double patenting rejection below, Applicants respectfully request reconsideration and withdrawal of this rejection.

REJECTION OF CLAIMS 1 TO 21 AS OBVIOUS OVER CLAIMS 1 TO 23 OF US PATENT NO. 6,462,198

Claims 1 to 21 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 to 23 of U.S. Patent No. 6,462,198 (hereinafter "the '198 patent"). In making this rejection, the Office Action states that the compounds of the '198 patent and those of the instant claims are structurally similar and that any differences would be obvious to those skilled in the art.

Applicants traverse this rejection because the compounds of the instant claims have unobvious properties over those claimed in the '198 patent. The activity of the compounds of the '198 patent against the mGlu 1a receptor was tested in accordance with the procedure described in Schlaeger et al., New Dev. New Appl. Anim. Cell Techn. Proc. ESACT Meet., 15, 1998, 105-112 and 117-120. (Col. 12, line 49 to Col 13, line 13). The data of representative compounds is provided in the table in Column 12 of the patent. The same disclosure is provided in Bleicher et al. at page 14, line 11 to page 15, line 5. The activity of the compounds of the instant claims was tested using the same test as that employed in the '198 patent and Bleicher et al. (paragraphs [0031] to [0033]). As can be seen from the data, these compounds have significantly lower EC₅₀ values than the compounds of the '198 patent, and thus are superior mGlu1aR agonists. In addition, the compounds of the instant claims have been found to have high metabolic stability as shown in the assay and data provided in paragraph [0035] of the instant application.

Applicants submit that the compounds of the instant invention are not obvious over the compounds of the claims of the '198 patent in view of the data discussed above showing that the compounds of the instant claims have superior agonist activity and stability over the compounds of the '198 patent.

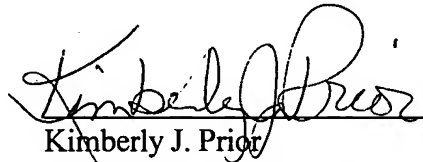
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For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

The foregoing amendment is fully responsive to the Office Action issued July 5, 2005. Applicants submit that Claims 1 to 21 are allowable. Early and favorable consideration is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kimberly J. Prior", is written over a horizontal line.

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